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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/150,577 | 09/10/1998 | DENNIS M. O'CONNOR | INTL-0100-US | 6643 |

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EXAMINER

CHEVALIER, ROBERT

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/150,577 | Applicant(s) O'CONNOR ET AL. | |
| | Examiner Bob Chevalier | Art Unit 2615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-14, 16-25 is/are rejected.
- 7) ☒ Claim(s) 12 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 1998 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 112

1. Claims 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example:

(1) Claim 24, line 5, the expression "said storage device" recited thereof does not a clear antecedent basis.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 16-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sata et al in view of Gould.

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Sata et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 1, and 16, including the feature of allowing a first portion of a video stream to be written to a storage medium while a second portion of a video stream is being read from the storage medium as specified in the present claims 1, and 16 (See Sata et al's Figure 1, components 3-7).

Sata et al fails to specifically disclose the feature of the zoom function being applied to the reproduced second portion of the video stream as specified in the present claims 1, and 16.

Gould discloses a retrieving device including the feature of the zoom function as specified in the present claims 1, and 16. (See Gould's abstract, and Figure 18).

It would have been obvious to one skilled in the art to modify the Sata et al's recording/reproducing apparatus wherein the reproducing means provided thereof would incorporate the capability of applying a zoom function to the reproduced video data in the same conventional manner as is shown by Gould. The motivation being to better identify the reproduced video data display on the display means as suggested by Gould.

With regard to claims 2-3, and 17, the feature of the hard disk and the random access media recited thereof is present in the proposed combination indicated above. (See Sata et al's Figure 1, component 4).

With regard to claims 4-5, the feature of retrieving and displaying two or more frames as specified thereof is present in the proposed combination indicated above. (See Sata et al's Figure 1, component 3-7, and the corresponding disclosure), and

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furthermore, the feature of allowing the user to select the frames of the video stream as a starting point for playing back the video stream as specified thereof would be inherently present in the proposed combination indicated above, because, conventional disk reproducing apparatuses such as the one disclosed by the Sata et al's reproducing apparatus already include the capability to randomly access and retrieving the recorded video signal from the disk recording medium at any position as desired.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6-8, 18, are rejected under 35 U.S.C. 102(b) as being anticipated by Mankovitz.

Mankovitz discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 6, and 18, including the feature of selecting a program from a provided a program guide linked to a storage device and automatically recording the program as specified in the present claims 6, and 18. (See Mankovitz's Figure 1, components 30, and 40).

With regard to claim 7, the feature of allowing the program guide to be selected by mouse clicking an icon on a television display screen as specified thereof would be present in Mankovitz. (See Mankovitz's Figures 8-9).

With regard to claim 8, the feature of the remote control recited thereof is present in Mankovitz. (See Mankovitz's Figure 6).

7. Claims 9-10, and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Sata et al.

Mankovitz discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 9, and 19, including the feature of recording a program selected from a program guide on a storage medium as specified in the present claims 9, and 19. (See Mankovitz's Figure 1).

Mankovitz fails to specifically disclose the feature of writing while reading a video signal to and from a recording medium as specified in claims 9, and 19.

Sata et al discloses a video recording/reproducing apparatus which includes the capability of writing while reading a video signal to and from a recording medium as specified in the present claims 9, and 19. (See Sata et al's Figure 1, components 3-5).

It would have been obvious to one skilled in the art to modify the Mankovitz's recording/reproducing apparatus wherein the recording/reproducing means provided thereof (See Mankovitz's Figure 1, component 40a) would incorporate the capability of writing while reading a video signal to and from a recording medium in the same conventional manner as disclosed by Sata et al. The motivation being to be able to watch precedingly recorded program in the middle of a recording session at any desired time, thereby increase the efficiency of the apparatus as suggested by Sata et al.

With regard to claim 10, the feature of retrieving and displaying two or more frames as specified thereof is present in the proposed combination indicated above.

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(See Sata et al's Figure 1, component 3-7, and the corresponding disclosure), and furthermore, the feature of allowing the user to select the frames of the video stream as a starting point for playing back the video stream as specified thereof would be inherently present in the proposed combination indicated above, because, conventional disk reproducing apparatuses such as the one disclosed by the Sata et al's reproducing apparatus already include the capability to randomly access and retrieving the recorded video signal from the disk recording medium at any position as desired.

8. Claims 11, 13-14, and 20-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sata et al in view of Honjo.

Sata et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 11, 13, 20, and 24, including the feature of alternately writing and reading a video data to and from a recording medium as specified in the present claims 11, 13, 20, and 24. (See Sata et al's Figure 1, components 3-5).

Sata et al fails to specifically disclose the feature of storing in a temporary buffer the next portion of a video signal to be written to the recording medium as specified in the present claims 11, 13, 20, and 24.

Honjo discloses a video recording/reproducing apparatus which includes the feature of storing in a temporary buffer the next portion of a video signal to be written to the recording medium as specified in the present claims 11, 13, 20, and 24. (See Honjo's Figure 1, component 2).

It would have been obvious to one skilled in the art to modify the Sata et al's recording/reproducing apparatus wherein the recording means provided thereof would incorporate the capability of a buffer means for temporary storing the video signal to be written on the storage medium in the same conventional manner as shown by Honjo. The motivation being to have a better control over the transfer rate of data to the recording medium as suggested by Honjo.

With regard to claim 14, the feature of compressing the video data recited thereof is present in the proposed combination indicated above. (See Sata et al's Figure 4, component 102d).

With regard to claims 21-23, and 25, the feature of the plurality of buffers recited thereof would be present in the proposed combination indicated above. (See Honjo's Figure 1, component 2, and Figure 4, component 11).

9. Claims 12, 15, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

B. Chevalier
March 9, 2002


ROBERT CHEVALIER
PRIMARY EXAMINER